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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Laurence B. Boucher, et al. Serial No: 10/724,588
Filing Date: November 28, 2003 Examiner: Wen Tai Lin
Atty. Docket No: ALA-025 GAU: 2154
For: INTELLIGENT NETWORK INTERFACE SYSTEM AND METHOD
FOR ACCELERATED PROTOCOL PROCESSING

September 30, 2008

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO THE DIRECTOR UNDER 37 CFR §1.181

This is a Petition to revoke the reopening of prosecution by the Examiner, after a Decision on Appeal that Reversed all of the Examiner's rejections.

I. The Final Rejection after Complete Reversal

On August 19, 2008, in response to the Board's Reversal of June 16, 2008, the Examiner reopened prosecution with a new Final Rejection over the same reference¹ that he used in the previous Final Rejection that was Reversed by the Board. Previously, the Examiner alleged anticipation and obviousness over the reference, although the obviousness rejection was withdrawn in the Examiner's Answer, so the Decision on Appeal only explicitly Reversed the anticipation rejection. In the latest Final Rejection, the Examiner has only alleged obviousness over the same reference.

The Examiner stated, in making the rejection final, "Applicant's previous amendment, which was filed 11/17/05, necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL."

¹ U.S. Patent No. 6,345,302 to Bennett et al.

II. The Examiner's Failure to Follow the Patent Rules and the MPEP

The Examiner apparently reopened prosecution on his own accord, despite rules that require approval for the reopening following such a complete Reversal to include the signature of the Technology Center (TC) Director if not the Director.

For example, MPEP §1214.04 states:

A complete reversal of the examiner's rejection brings the case up for immediate action by the examiner. If the reversal does not place an application in condition for immediate allowance (e.g., the Board has entered a new ground of rejection under 37 CFR 41.50(b)), the examiner should refer to the situations outlined in MPEP § 1214.06 for appropriate guidance.

The examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references. This is particularly so where the application or *ex parte* reexamination proceeding has meanwhile been transferred or assigned to an examiner other than the one who rejected the claims leading to the appeal. The second examiner should give full faith and credit to the prior examiner's search.

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP § 1002.02(c) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution.

There is no indication that the Technology Center (TC) Director's authorization was sought or obtained to reopen prosecution in this case, contrary to the above Section. The TC Director's approval was not placed on the action reopening prosecution, contrary to the above Section.

Moreover, in the current case the Examiner has reopened prosecution over the same reference over which he was completely Reversed, in contrast to finding a new reference that was not considered by the Board. This is probably such an unusual situation that it is not even mentioned by the MPEP, but clearly the need to obtain the TC Director's authorization is even stronger in this case.

In addition, MPEP §1214.06, to which the above-quoted Section says "the examiner should refer ... for appropriate guidance," refers to the situation in which the "Examiner (is) Sustained in Whole or in Part." In contrast, in the current case the

Examiner was completely Reversed, again making the need to obtain the TC Director's authorization even stronger.²

In accordance with the above, MPEP §1214.06 requires the Examiner to issue any claims for which he or she was reversed, stating in part:

II. CLAIMS STAND ALLOWED

The appellant is not required to file a reply. The examiner issues the application or *ex parte* reexamination certificate on the claims which stand allowed. *>For paper files, a< red-ink line should be drawn through the refused claims and the notion "Board Decision" written in the margin in red ink.

If the Board affirms a rejection of claim 1, claim 2 was objected to prior to appeal as being allowable except for its dependency from claim 1 and independent claim 3 is allowed, the examiner should cancel claims 1 and 2 and issue the application or *ex parte* reexamination certificate with claim 3 only.

In other words, those claims that the Board allowed are to be issued, not reargued, especially over the same reference. Similarly, MPEP §1214.07, which also refers to MPEP §1214.06, states:

In the event that claims stand allowed in the application under the conditions set forth in MPEP § 1214.06, paragraph II, the application should be passed to issue.

Moreover, 37 CFR §1.198 states:

37 CFR 1.198. Reopening after a final decision of the Board of Patent Appeals and Interferences.

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

Section 1.114 involves cases for which a Request for Reconsideration (RCE) has been filed, and Section 41.50 has to do with a New Ground of Rejection issued by the

² Note that even for the less unusual situation in which prosecution is reopened after an Appeal Brief has been filed, long before a Decision on Appeal has been rendered, an Examiner must obtain the approval and signature of a Supervisory Examiner. See MPEP 1207.04, including form paragraph 12.187. Even the approval of a Supervisory Examiner is lacking in this case, although the signature of the Supervisory Examiner would not satisfy the rules for reopening prosecution after a complete Reversal.

Board, neither of which is appropriate here.³ Note also that Rule 198 requires “the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.” In contrast, applicants respectfully assert that “the written authority of the Director” is absent in present case, the “matter” was “already adjudicated” by the Board, and “sufficient cause (was not) shown.”

III. Conclusion

As discussed above, the Examiner has ignored the rules for reopening prosecution after a complete Reversal by the Board. The Examiner has failed, at a minimum, to obtain the approval of the Director or the TC Director to reopen prosecution with a new Final Rejection. As mentioned in MPEP §1214.04 quoted above, one reason to require approval for reopening prosecution after a Reversal is to avoid the Examiner viewing the Reversal as a challenge to make a new rejection. Particularly in the current case, in which the Examiner has repeatedly made rejections that failed to state a *prima facie* case of anticipation or obviousness, has ignored applicants’ arguments and the Board’s Decision, and has issued a new rejection that is Final, so that applicants will suffer the time and cost of another Appeal as well as reducing the term of the patent that will issue, the new Final Rejection over the same reference should be revoked.

Applicants respectfully urge the Director to require the Examiner to allow the pending claims or to obtain the signature of the TC Director before issuing a new rejection over the same reference for which he was earlier Reversed.


Respectfully submitted,

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with sufficient postage in the US Postal Service as first class mail in an envelope addressed to: MS Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 30, 2008.

Date: 9-30-08


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³ Note that the Examiner or Board could have but did not make a New Ground of Rejection over the reference cited by the Examiner in the latest Final Rejection, as it is the same reference that was argued extensively before the Board.